

REMARKS

Claims 1-24 and 26-28 are pending in this application. By this Amendment, claim 1 is amended, and claims 27 and 28 are added. Support for the amendments to claim 1 and the new claims may be found, for example, in the specification at paragraphs [0001]-[0002], [0014], [0105], [0108], [0112], [0160] and [0168] and in the original claims. No new matter is added.

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

I. Obviousness-Type Double Patenting Rejections

The Office Action provisionally rejects under the judicially created doctrine of obviousness-type double patenting:

- (1) Claims 1-24 and 26 as being unpatentable over claims 1-28 of co-pending Application No. 11/822,111 in view of U.S. Patent No. 4,853,454 to Merger et al. ("Merger") and U.S. Patent No. 5,116,931 to Reisch et al. ("Reisch");
- (2) Claims 1-24 and 26 as being unpatentable over claims 1-30 of co-pending Application No. 12/000,763 in view of Merger;
- (3) Claims 1-24 and 26 as being unpatentable over claims 1-25 of co-pending Application No. 10/501,074 in view of U.S. Patent No. 4,853,454 to Merger;
- (4) Claims 1-24 and 26 as being unpatentable over claims 1-21 of co-pending Application No. 10/501,078 in view of Merger and Reisch;
- (5) Claims 1-24 and 26 as being unpatentable over claims 1-31 of co-pending Application No. 10/522,412 in view of Merger;
- (6) Claims 1-24 and 26 as being unpatentable over claims 1-25 of co-pending Application No. 11/470,588 in view of Merger; and

(7) Claims 1-24 and 26 as being unpatentable over claims 1-25 of co-pending Application No. 12/056,043 in view of Merger.

The provisional rejections are respectfully traversed.

Because the cited co-pending applications have not issued, filing a Terminal Disclaimer to obviate provisional double-patenting rejections is premature. See MPEP §706.02(k). Applicants respectfully request that the double patenting rejections be held in abeyance.

II. Rejection Under 35 U.S.C. §112

The Office Action rejects claims 1-24 and 26 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

The Office Action asserts that the specification does not define the term "pack" in the claimed two-pack polyurethane composition. However, the specification discloses that the two components are separately stored in "suitable packaging or devices, such as for example in a drum, a bag, or a cartridge..." or in "a container where they are separated by a partition." See specification at paragraphs [0110]-[0111]. From such disclosure, an ordinarily skilled artisan would understand that "pack" means a package containing specific contents, such as polyurethane prepolymer in a first pack, and water and polyaldimine in a second pack, as recited in claim 1. Thus, claims 1-24 and 26 comply with the written description requirement.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections Under 35 U.S.C. §103

A. Claims 1-5, 9, 11-16, 19, 20, 23, 24 and 26

1. Merger and Pedain

The Office Action rejects claims 1-5, 9, 11-16, 19, 20, 23, 24 and 26 under 35 U.S.C. §103(a) as having been obvious over Merger in view of U.S. Patent No. 4,895,883 to Pedain et al. ("Pedain"). Applicants respectfully traverse the rejection.

Claim 1 is directed to a two-pack polyurethane composition wherein at least one of the first and second pack comprises a filler, and a mixed polyurethane composition resulting from mixing the contents of the two packs **A** and **B** is pasty. See specification at paragraphs [0001]-[0002], [0014], [0105], [0112], [0160] and [0168]. The applied references would not have rendered obvious the claimed polyurethane composition for at least the following reasons.

An ordinarily skilled artisan would not have had any reason or rationale to apply the teachings of Pedain, in combination with Merger, to achieve the claimed polyurethane composition. Pedain is directed to polyurethane ureas obtained by reacting a hydrophilic NCO prepolymer with an aldimine or ketimine-containing hardener mixture in the presence of water and organic solvents. See Pedain at col. 1, lines 34-47. Pedain teaches that the polyurethane composition is used in a two-component PU spray gun. See Pedain at col. 11, lines 11-19. The reaction of the constituents to form the polyurethane composition is extremely fast, as the reaction begins immediately in the mixing tube of the spray gun. See Pedain at col. 11, lines 15-22. Once mixed, the polyurethane composition is forced through the exit nozzle by compressed air. *Id.* Thus, in order for the spray gun to be operable, the polyurethane composition must have very low viscosity (i.e., thin consistency). Therefore, Pedain does not teach that the polyurethane composition is pasty.

Furthermore, Pedain fails to disclose that its polyurethane composition comprises a filler. The present specification teaches that the filler may be an inorganic or organic filler, such as ground or precipitated calcium carbonates, which optionally are coated with stearates, in particular finely divided coated calcium carbonate, carbon black, kaolins, aluminum oxides, silicic acids and PVC powder or hollow spheres. See specification at paragraph [0108]. Nowhere in Pedain does it disclose any such fillers, much less any additives added to the polyurethane composition.

Additionally, the polyaldimine **B1** of the claimed polyurethane composition is obtained such that the aldehyde is used in stoichiometric proportion or in stoichiometric excess relative to the primary amino groups of polyamine **PA**. See specification at paragraph [0097]. Thus, no non-aldiminized or free amino groups are present in the second pack **B** of the claimed polyurethane composition. In contrast, because the reaction of the constituents is extremely fast, non-aldiminized or free amino groups are present in the polyurethane composition of Pedain. See Pedain at col. 10, lines 27-55 (disclosing that 12.9 mole % were present in the mixture as free IPDA).

Therefore, an ordinarily skilled artisan looking to produce a polyurethane composition that (1) comprises a filler, (2) has a pasty consistency, and (3) lacks any non-aldiminized or free amino groups would not have had any reason or rationale to apply Pedain that teaches a polyurethane composition that (1) does not comprise any fillers, (2) that has thin consistency, and (3) that comprises non-aldiminized or free amino groups.

2. Pedain and Merger

The Office Action rejects claims 1-5, 9, 11-16, 19, 20, 23, 24 and 26 under 35 U.S.C. §103(a) as having been obvious over Pedain in view of Merger. Applicants respectfully traverse the rejection.

As discussed above, Pedain teaches a polyurethane composition that (1) does not comprise any fillers, (2) that has thin consistency, and (3) that comprises non-aldiminized or free amino groups. Therefore, as discussed above, an ordinarily skilled artisan would not have had any reason or rationale to apply Pedain, in combination with Merger, to achieve the claimed polyurethane composition.

3. Conclusion

For at least these reasons, the applied references would not have rendered obvious claim 1 and its dependent claims. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 6-8, 10, 17, 18, 21 and 22

The Office Action rejects under 35 U.S.C. §103(a):

- (1) Claims 6-8 and 10 as having been obvious over Merger in view of Pedain, and further in view of U.S. Patent No. 3,935,274 to Jacobsen et al. ("Jacobsen");
- (2) Claims 17 and 18 as having been obvious over Merger in view of Pedain, and further in view of Reisch;
- (3) Claims 21 and 22 as having been obvious over Merger in view of Pedain, and further in view of U.S. Patent No. 5,194,488 to Piestert et al. ("Piestert");
- (4) Claims 6-8 and 10 as having been obvious over Pedain in view of Merger, and further in view of Jacobsen;
- (5) Claims 17 and 18 as having been obvious over Pedain in view of Merger, and further in view of Reisch; and
- (6) Claims 21 and 22 as having been obvious over Pedain in view of Merger, and further in view of Piestert.

Claims 6-8, 10, 17, 18, 21 and 22 depend from claim 1 and, thus, contain all of the features of claim 1. Deficiencies of Merger and Pedain with respect to claim 1 are discussed

above. Jacobsen, Reisch and Piestert, which are applied by the Office Action for the additional features recited in claims 6-8, 10, 17, 18, 21 and 22, do not cure deficiencies of Merger and Pedain with respect to claim 1.

Thus, the applied references would not have rendered obvious claims 6-8, 10, 17, 18, 21 and 22. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

IV. New Claims

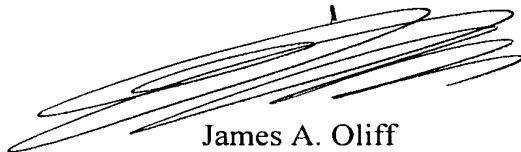
By this Amendment, new claims 27 and 28 are presented. New claims 27 and 28 depend from claim 1 and, thus, distinguish over the applied references for at least the reasons discussed above with respect to claim 1. Prompt examination and allowance of new claims 27 and 28 are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Amendment Transmittal

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